

REMARKS

The undersigned thanks Examiner Schillinger for the courtesies extended during the interview of October 20, 2010. During the interview, The Examiner said that the amendment and new claims do not pose any 112 issues. However, the Examiner said that she has to do another prior art search.

Applicants respectfully request reconsideration of the present Application in view of the foregoing amendments and in view of the reasons that follow.

With this Amendment, claims 1 and 9 have been amended; claims 14-16 and withdrawn claims 23-36 have been canceled without prejudice or disclaimer of the subject matter recited in these claims; and, claims 37-57 are new. A detailed listing of all claims that are, or were, in the Application, irrespective of whether the claims remain under examination in the Application, is presented, with appropriately defined status identifiers. Thus, claims 1-13, 17-22, and 37-57 remain pending in the Application.

Support for the amendments to claim 1 can be found in the disclosure in at least the original claims 14-16, now canceled. Claim 9 has been amended to fix a minor typographical error. Support for new claims 37, 38 and 41-57 can be found in at least original claims 1-22. Support for “micro-structured surface features” and “surface morphology” in claim 37 is found in paragraphs [0028] and [0041] of the present application published as U.S. Publication No. 20060149391. Support for claims 39 and 40 is found in paragraphs [0038] – [0041] of U.S. Publication No. 20060149391. No new matter has been added.

Claims rejections under 35 U.S.C. § 112

The outstanding Official Action has rejected claims 1-22 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description.

This rejection is respectfully traversed and should be withheld as claim 1 no longer recites precision engineered surface features that are substantially uniform to which the Examiner had objected.

Claims rejections under 35 U.S.C. § 103

The outstanding Official Action has rejected claims 1, 5, 6, 8-13, 16, 17, and 19-22 under 35 U.S.C. § 103 as allegedly being unpatentable over Horton et al. (U.S. Patent Publication No. 2002/0162605, hereinafter Horton) in view of Rogers et al. (U.S. Patent No. 6,159,010, hereinafter Rogers).

This rejection is respectfully traversed.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). *See also* MPEP 2143.03. Claim 1 recites, *inter alia*, “said alloy having a composition that is free from Al or Ni.” Horton is relied upon for teaching a Be-free alloy. The cited prior art references, however, *as a whole* fail to teach or suggest an alloy composition free from Al or Ni.

The outstanding Official Action has rejected claims 2-4 under 35 U.S.C. § 103 as allegedly being unpatentable over Horton in view of Rogers, further in view of Scheicher (U.S. Patent No. 4,278,630).

This rejection is respectfully traversed and should be withdrawn as claims 2-4 depend from claim 1, which should now be allowable.

The outstanding Official Action has rejected claims 14 and 15 under 35 U.S.C. § 103 as allegedly being unpatentable over Horton in view of Rogers, further in view of Lin et al. (U.S. Patent No. 5,797,443, hereinafter Lin).

This rejection is respectfully traversed and should be withdrawn as claims 14 and 15 depend from claim 1, which should now be allowable.

The outstanding Official Action has rejected claim 18 under 35 U.S.C. § 103 as allegedly being unpatentable over Horton in view of Rogers, further in view of Oshida (U.S. Patent No. 6,066,176).

This rejection is respectfully traversed and should be withdrawn as claim 18 depends from claim 1, which should now be allowable.

CONCLUSION

In view of the above amendment, applicant believes the pending application is in condition for allowance. The Director is authorized to charge any fees necessary and/or credit any overpayments to Deposit Account No. 03-3975, referencing Docket No. 069648-0388443.

Respectfully submitted,

Dated: October 20, 2010

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